

REMARKS

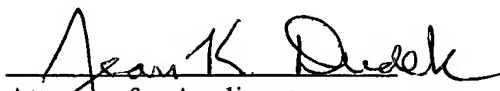
Favorable reconsideration and allowance of the subject application are respectfully solicited.

Claims 27-58 are pending in this application, with Claims 27, 54 and 55 being independent. Claims 1-26 and 59-94 are cancelled herein without prejudice to or disclaimer of the subject matter contained therein. Since the only claims remaining in the application (Claims 27-58) are allowed, this application is in condition for allowance. Therefore, favorable consideration and entry of this Amendment and issuance of a Notice of Allowance are respectfully requested.

The Office Action Summary indicates that the Form PTO-1449 from the May 25, 2004 Information Disclosure Statement is attached. This Form was not attached, and it is respectfully requested that it be attached to the next paper from the Patent and Trademark Office in this application. Also, acknowledgment of the claim for priority and receipt of the certified copy (filed on March 25, 2002) has not been made. It is respectfully requested that the Examiner do so in the next paper.

Applicants' undersigned attorney may be reached in our Washington, D.C.
office by telephone at (202) 530-1010. All correspondence should continue to be directed to our
below-listed address.

Respectfully submitted,



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**THE STATE INTELLECTUAL PROPERTY OFFICE OF
THE PEOPLE'S REPUBLIC OF CHINA**

CCPIT Patent and Trademark Law Office
8th Floor, 2 Fuchengmenwai Street,
Beijing 100037, China

LIU YUANXIA
Examiner

Seal of the
Examination
Department

Application No.:	01144086.4	Examination Dept.	Date of Notification: Date: <u>06</u> Month: <u>08</u> Year: <u>2004</u>
Attorney:			
Applicant:	CANON KABUSHIKI KAISHA		
Title of the Invention:	RECORDED MATTER, METHOD OF PRODUCING THE SAME AND USE THEREOF		

Notification of the First Office Action

1. ☒ The applicant requested examination as to substance on _____ and examination has been carried out on the above-identified patent application for invention under Article 35(1) of the Patent Law of the People's Republic of China(hereinafter referred to as "the Patent Law").
☐ The Chinese Patent Office has decided to examine the application on its own initiative under Article 35(2) of the Patent Law.

2. ☒ The applicant claimed priority/priorities based on the application(s):
 filed in JP on Dec. 28, 2000, filed in _____ on _____,
 filed in _____ on _____, filed in _____ on _____,
 filed in _____ on _____, filed in _____ on _____,
☒ The applicant has provided the priority documents certified by the Patent Office where the priority application(s) was/were filed.
☐ The applicant has not provided the priority documents certified by the Patent Office where the priority application(s) was/were filed and therefore the priority claim(s) is/are deemed not to have been made under Article 30 of the Patent Law.
☐ The application is a PCT continuation.

3. ☐ The applicant submitted amendments to the application on _____ and on _____, wherein the amended _____ submitted on _____ and the amended _____ submitted on _____ are not acceptable, because said amendments do not comply with ☐Article 33 of the Patent Law.
☐Rule 51 of the Implementing Regulations of the Patent Law.
 The specific reasons why the amendments are not allowable are set forth in the text portion of this Notification.

4. ☐ Examination as to substance was directed to the initial application documents as filed.
☒ Examination as to substance was directed to the documents as specified below:
 claims 1-94, pages 2-35 of the description and drawings 1-9 filed on the date of filing,
 claims _____, pages 1 of the description and drawings _____ submitted on Apr.3,2002,
 claims _____, pages _____ of the description and drawings _____ submitted on _____,
 and the abstract submitted on Dec.28,2001.

5. ☐ This Notification is issued without search reports.
☒ This Notification is issued with consideration of the search results.
☒ Below is/are the reference document(s) cited in this Office Action(the reference number(s) will be used throughout the examination procedure):

No.	Number(s) or Title(s) of Reference(s)	Date of Publication (or the filing date of conflicting application)
1	US6142618A	Date: <u>07</u> Month: <u>11</u> Year: <u>2000</u>
2		Date: __ Month: __ Year: __
3		Date: __ Month: __ Year: __
4		Date: __ Month: __ Year: __

6. Conclusions of the Action:

☐ On the Specification:

- ☐ The subject matter contained in the application is not patentable under Article 5 of the Patent Law.
- ☐ The description does not comply with Article 26 paragraph 3 of the Patent Law.
- ☐ The draft of the description does not comply with Rule 18 of the Implementing Regulations.

☒ On the Claims:

- ☐ Claim(s) _____ is/are not patentable under Article 25 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with the definition of inventions prescribed by Rule 2 paragraph 1 of the Implementing Regulations.
- ☒ Claim(s) 1,3-6,27,29-32,54,55,59,61-63,82-86,89-91,94 does/do not possess the novelty as required by Article 22 paragraph 2 of the Patent Law.
- ☒ Claim(s) 2,7-26,28,33-53,56-58,60,64-81,87,92-93 does/do not possess the inventiveness as required by Article 22 paragraph 3 of the Patent Law.
- ☐ Claim(s) _____ does/do not possess the practical applicability as required by Article 22 paragraph 4 of the Patent Law.
- ☒ Claim(s) 1,27,54,55,59,82,84-86,91,94 does/do not comply with Article 26 paragraph 4 of the Patent Law.

Law.

- ☐ Claim(s) _____ does/do not comply with Article 31 paragraph 1 of the Patent Law.
- ☒ Claim(s) 6,26,32,63 does/do not comply with the provisions of Rules 20-23 of the Implementing Regulations.
- ☐ Claim(s) _____ does/do not comply with Article 9 of the Patent Law.
- ☐ Claim(s) _____ does/do not comply with the provisions of Rule 12 paragraph 1 of the Implementing Regulations.

7. In view of the conclusions set forth above, the Examiner is of the opinion that:

- ☐ The applicant should make amendments as directed in the text portion of the Notification.
- ☒ The applicant should expound in the response reasons why the application is patentable and make amendments to the application where there are deficiencies as pointed out in the text portion of the Notification, otherwise, the application will not be allowed.
- ☐ The application contains no allowable invention, and therefore, if the applicant fails to submit sufficient reasons to prove that the application does have merits, it will be rejected.

☐

8. The followings should be taken into consideration by the applicant in making the response:

- (1) Under Article 37 of the Patent Law, the applicant should respond to the office action within 4 months counting from the date of receipt of the Notification. If, without any justified reason, the time limit is not met, the application shall be deemed to have been withdrawn.
- (2) Any amendments to the application should be in conformity with the provisions of Article 33 of the Patent Law. Substitution pages should be in duplicate and the format of the substitution should be in conformity with the relevant provision contained in "The Examination Guidelines".
- (3) The response to the Notification and/or revision of the application should be mailed to or handed over to the "Reception Division" of the Patent Office, and documents not mailed or handed over to the Reception Divisions have no legal effect.
- (4) Without an appointment, the applicant and/or his agent shall not interview with the Examiner in the Patent Office.

9. This Notification contains a text portion of 4 pages and the following attachments:

- ☒ 1 cited reference(s), totaling 20 pages. ☐

Text Portion of the Notification of the First Office Action

The present invention relates to a technique to improve fastness of an image formed by an ink jet process in an ink-receiving layer having a porous structure, and have total 94 claims, wherein (1) claims 1-26 seek to protect a recorded matter having an ink-receiving layer of a porous structure; (2) claims 27-53 seek to protect a method of manufacturing a recorded matter having an ink-receiving layer of a porous structure; (3) claims 54-58 seek to protect a method of improving image fastness of a recorded matter; (4) claims 59-81 seek to protect an image-fastness improving agent for improving image fastness of a recorded matter; (5) claims 82-83 seeks to protect a kit for improving image fastness of a recorded matter; (6) claim 84 seeks to protect a dispenser containing an image fastness-improving agent according to claim 59; (7) claim 85 seeks to protect an applicator for an image fastness-improving agent; (8) claim 86-93 seek to protect a method of improving fastness of an image on a recording medium; and (9) claim 94 seeks to protect a kit of improving image fastness. After examination, the examiner's comments are as follows.

1. Novelty

- 1) Claim 27 seeks to protect a method of manufacturing a recorded matter having an ink-receiving layer of a porous structure. The reference D1 (US6142618A) (see column 7 lines 20-60) discloses a method comprising: (1) applying an ink to the ink-receiving layer to obtain an image region where an image is formed with a coloring material contained in the ink (see column 7 lines 20-23); (2) applying a liquid comprising a non-volatile liquid not dissolving the coloring material to the ink-receiving layer (see column 7 lines 40-53). Although D1 does not disclose the step (3) of claim 27: forming a portion in which all or substantially all of the coloring material distributing in a thickness direction of the ink-receiving layer is embedded in the non-volatile liquid,

D1 also uses a recorded matter having an ink-receiving layer of a porous structure and can obviously achieve the effect of step (3) under the capillary action of porous structure. It can be seen that the technical solution of claim 27 is disclosed by D1, and both claim 27 and D1 belong to the same technical field, solve the same technical problem and bring about the same technical effect. Hence, claim 27 does not comply with Article 22(2) of the Patent Law for lack of novelty in comparison with D1.

2) The recorded matter having an ink-receiving layer of a porous structure as claimed in claim 1 is disclosed by D1 (see column 7 lines 20-60 and columns 23-31); the method of improving image fastness of a recorded matter as claimed in claims 54, 55 and 86 are disclosed by D1 (column 7 lines 20-60 and columns 23-31); the image-fastness improving agent for improving image fastness of a recorded matter as claimed in claim 59 is disclosed by D1 (see column 7 lines 20-60, column 10 line 38 to column 18 line 30, columns 23-31); the kit for improving image fastness of a recorded matter as claimed in claim 82 is disclosed by D1 (see column 7 line 54 to column 10 line 37); the kit of improving image fastness as claimed in claim 94 is disclosed by D1 (see column 7 line 20 to column 18 line 30, and columns 23-31); and, the dispenser of claim 84 containing an image fastness-improving agent according to claim 59 and the applicator of claim 85 for an image fastness-improving agent are disclosed by D1 (see column 7 line 54 to column 10 line 37, and Figures 1-3). Thus, according to the same reasons of item 1), claims 1, 54, 55, 59, 82, 84-86 and 94 do not comply with Article 22(2) of the Patent Law for lack of novelty in comparison with D1.

3) The technical features of claims 3-6, 29-32, 61-63, 83 and 88-91 for further defining the cited claims are disclosed by D1 (see also the comments of item 2)). For example, the modified silicone oil disclosed in column 16 of D1 falls within the protection scope of claim 6, which is corresponding to the modified silicone oil of claim 6 wherein R1, R2 and R3 are methyl, and R4 is substituted alkyl. Hence, claims 3-6,

29-32, 61-73, 83 and 88-91 do not comply with Article 22(2) of the Patent Law for lack of novelty in comparison with D1.

2. Inventiveness

Claims 2 and 7-26 directly or indirectly further define claim 1; claims 28 and 33-53 directly or indirectly further define claim 27; claims 56-58 directly or indirectly further define claim 54 or 55; claims 60 and 64-81 directly or indirectly further define claim 59; and claims 87 and 92-93 directly or indirectly further define claim 86. However, according to the disclosures contained in the description, it cannot be seen that the technical solutions further defined in these claims bring about any unexpected technical effect over D1. Hence, claims 2, 7-26, 28, 33-53, 56-58, 60, 64-81, 87 and 92-93 do not comply with Article 22(3) of the Patent Law for lack of inventiveness.

3. If the applicant could overcome the defects about lack of novelty and submit sufficient reasons to prove that the present application has inventiveness, the present application still has the following defects.

- 1) The protection scope of claim 1 is relatively broad. The description merely discloses the non-volatile liquids of claims 6-8, 13, 15 and 18, whereas claim 1 covers a large number of non-volatile various in structure and property, and a person skilled in the art cannot predict that all non-volatile liquids can solve the same technical problem and achieve the same technical effect. Hence, claim 1 does not comply with Article 26(4) of the Patent Law for lack of support in the description.
- 2) For the same reasons, the concept of non-volatile liquid in claims 27, 54, 55, 59, 82, 84-86 and 94 covers a relatively broad protection scope. Thus, these claims do not comply with Article 26(4) of the Patent Law for lack of support in the description either.
- 3) The technical solution of claim 91 is not recorded in the description, and thus does not comply with Article 26(4) of the Patent Law for lack

of formal support in the description. The applicant is invited to incorporate said technical solution into the description.

- 4) Claims 6, 32 and 63 do not define the substituents relating to the terms of "substituted or unsubstituted alkyl group, a functional substituent having a UV absorbency and an antioxidant function". Hence, said claims do not comply with Rule 20(1) of the Implementing Regulations of the Patent Law for lack of clarity in protection scope.

The term "silicon oxide" in claim 26 is not consistent with the term "silica" in the description. Hence, claim 26 does not comply with Rule 20(1) of the Implementing Regulations of the Patent Law for lack of clarity in protection scope.

Due to the above reasons, the present application cannot be allowed based on the present text. The applicant is invited to overcome all aforementioned defects within the time limit specified in the notification; otherwise, the present application will be rejected.

中华人民共和国国家知识产权局

邮政编码: 100037

北京市阜成门外大街2号万通新世界广场8层
中国国际贸易促进委员会专利商标事务所
陈季壮

发文日期



013196

申请号: 011440864



申请人: 佳能株式会社

发明创造名称: 记录材料及其生产方法和用途

第一次审查意见通知书

1. ☒ 应申请人提出的实审请求, 根据专利法第35条第1款的规定, 国家知识产权局对上述发明专利申请进行实质审查。

☐ 根据专利法第35条第2款的规定, 国家知识产权局决定自行对上述发明专利申请进行审查。

2. ☒ 申请人要求以在:

JP 专利局的申请日 2000年12月28日为优先权日,
专利局的申请日 年 月 日为优先权日,
专利局的申请日 年 月 日为优先权日,
专利局的申请日 年 月 日为优先权日,
专利局的申请日 年 月 日为优先权日。

☒ 申请人已经提交了经原申请国受理机关证明的第一次提出的在先申请文件的副本。

☐ 申请人尚未提交经原申请国受理机关证明的第一次提出的在先申请文件的副本, 根据专利法第30条的规定视为未提出优先权要求。

3. ☐ 经审查, 申请人于:

年 月 日提交的 不符合实施细则第51条的规定;
年 月 日提交的 不符合专利法第33条的规定;
年 月 日提交的

4. 审查针对的申请文件:

☐ 原始申请文件。 ☒ 审查是针对下述申请文件的

申请日提交的原始申请文件的权利要求第 1-94 项、说明书第 2-35 页、附图第 1-9 页;

2002 年 4 月 3 日提交的权利要求第 项、说明书第 1 页、附图第 页;

年 月 日提交的权利要求第 项、说明书第 页、附图第 页;

年 月 日提交的权利要求第 项、说明书第 页、附图第 页;

2001 年 12 月 28 日提交的说明书摘要, 年 月 日提交的摘要附图。

5. ☐ 本通知书是在未进行检索的情况下作出的。

☒ 本通知书是在进行了检索的情况下作出的。

☒ 本通知书引用下述对比文献(其编号在今后的审查过程中继续沿用):

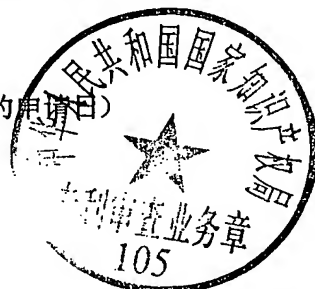
编号	文件号或名称	公开日期(或抵触申请的申请日)
1	US6142618A	2000-11-7

6. 审查的结论性意见:

☐ 关于说明书:

☐ 申请的内容属于专利法第5条规定的不授予专利权的范围。

☐ 说明书不符合专利法第26条第3款的规定。



21301
2002.8



回函请寄: 100088 北京市海淀区蓟门桥西土城路6号 国家知识产权局专利局受理处收
(注: 凡寄给审查员个人的信函不具有法律效力)

☐ 说明书不符合专利法第 33 条的规定。

☐ 说明书的撰写不符合实施细则第 18 条的规定。

☐

☒ 关于权利要求书:

☒ 权利要求 1, 3-6, 27, 29-32, 54, 55, 59, 61-63, 82-86, 89-91, 94 不具备专利法第 22 条第 2 款规定的新颖性。

☒ 权利要求 2, 7-26, 28, 33-53, 56-58, 60, 64-81, 87, 92-93 不具备专利法第 22 条第 3 款规定的创造性。

☐ 权利要求 不具备专利法第 22 条第 4 款规定的实用性。

☐ 权利要求 属于专利法第 25 条规定的不授予专利权的范围。

☒ 权利要求 1, 27, 54, 55, 59, 82, 84-86, 91, 94 不符合专利法第 26 条第 4 款的规定。

☐ 权利要求 不符合专利法第 31 条第 1 款的规定。

☐ 权利要求 不符合专利法第 33 条的规定。

☐ 权利要求 不符合专利法实施细则第 2 条第 1 款关于发明的定义。

☐ 权利要求 不符合专利法实施细则第 13 条第 1 款的规定。

☒ 权利要求 6, 26, 32, 63 不符合专利法实施细则第 20 条的规定。

☐ 权利要求 不符合专利法实施细则第 21 条的规定。

☐ 权利要求 不符合专利法实施细则第 22 条的规定。

☐ 权利要求 不符合专利法实施细则第 23 条的规定。

☐

上述结论性意见的具体分析见本通知书的正文部分。

7. 基于上述结论性意见, 审查员认为:

☐ 申请人应按照通知书正文部分提出的要求, 对申请文件进行修改。

☒ 申请人应在意见陈述书中论述其专利申请可以被授予专利权的理由, 并对通知书正文部分中指出的不符合规定之处进行修改, 否则将不能授予专利权。

☐ 专利申请中没有可以被授予专利权的实质性内容, 如果申请人没有陈述理由或者陈述理由不充分, 其申请将被驳回。

☐

8. 申请人应注意下述事项:

(1) 根据专利法第 37 条的规定, 申请人应在收到本通知书之日起的肆个月内陈述意见, 如果申请人无正当理由逾期不答复, 其申请将被视为撤回。

(2) 申请人对其申请的修改应符合专利法第 33 条的规定, 修改文本应一式两份, 其格式应符合审查指南的有关规定。

(3) 申请人的意见陈述书和/或修改文本应邮寄或递交国家知识产权局专利局受理处, 凡未邮寄或递交给受理处的文件不具备法律效力。

(4) 未经预约, 申请人和/或代理人不得前来国家知识产权局专利局与审查员举行会晤。

9. 本通知书正文部分共有 3 页, 并附有下列附件:

☒ 引用的对比文件的复印件共 1 份 20 页。 ☐



审查员 雷元 (9483)

2004 年 7 月 24 日

审查部门 审查协作中心



第一次审查意见通知书正文

申请号：011440864

本发明涉及一种在具有多孔结构的油墨接收层中提高由喷墨方法形成的图像的牢度的技术，共94项权利要求，其中：1) 权利要求1-26为一种具有多孔结构的油墨接收层的记录材料；2) 权利要求27-53为一种制造具有多孔结构的油墨接收层的记录材料的方法；3) 权利要求54-58为一种提高记录材料的图像牢度的方法，4) 权利要求59-81为一种用于提高记录材料的图像牢度的图像牢度改进剂；5) 权利要求82-83为一种用于提高记录材料的图像牢度的总成盒；6) 权利要求84为一种包含根据权利要求59的图像牢度改进剂的分配器；7) 权利要求85为一种用于图像牢度改进剂的涂布器；8) 权利要求86-93为一种提高在记录介质上形成的图像的牢度的方法；9) 权利要求94为一种提高图像牢度的方法。经审查意见如下：

(一) 新颖性

1、(1) 权利要求27请求保护一种制造具有多孔结构的油墨接收层的记录材料的方法，对比文件1（参见US6142618A说明书第7栏第20-60行）包括（1）将油墨施用到油墨接收层上，得到其中图像由包含在油墨中的着色材料形成的图像区（第7栏第20-23行）；（2）将一种含有不溶解在着色材料的非挥发性的液体的液体施用到油墨接收层上（第7栏第40-53行）；尽管对比文件1没有给出步骤（3）形成其中在油墨接收层厚度方向上分布的所有或基本上所有着色材料被包埋在该非挥发性液体中的部分，但是由于对比文件1使用的同样多孔结构的油墨接收层，由于孔空间的毛细管作用，很显然能够达到步骤（3）同样的效果，由此可知，权利要求27请求保护的技术方案已经在对比文件1中公开，两者属于同样的技术领域，解决同样的技术问题，达到同样的技术效果，因此权利要求27相对于对比文件1不具有新颖性，不符合专利法第二十二条第二款的规定。

(2) 权利要求1请求保护一种具有多孔结构的油墨接收层的记录材料已经在对比文件1说明书第7栏第20-60行和第23-31栏中公开；权利要求54、55和86请求保护一种提高记录材料的图像牢度的方法已经在对比文件1说明书第7栏第20-60行和第23-31栏中公开；权利要求59请求保护一种用于提高记录材料的图像牢度的图像牢度改进剂已经在

对比文件1说明书第7栏第20-60行、第10栏第38行至第18栏第30行、第23-31栏中公开；权利要求82请求保护一种用于提高记录材料的图像牢度的总成分已经在对比文件1第7栏第54行至第10栏第37行中公开；权利要求94请求保护一种提高图像牢度的方法已经在对比文件1说明书第7栏第20行至第18栏第30行和第23-31栏中公开；权利要求84请求保护一种包含根据权利要求59的图像牢度改进剂的分配器和权利要求85请求保护的用与图像牢度改进剂的涂布器都已经在对比文件1的第7栏第54行至第10栏第37行以及附图1-3中公开，因此基于上述意见（1）同样的理由，权利要求1、54、55、59、82、84-86和94请求保护的技术方案相对于对比文件1不具有新颖性，不符合专利法第二十二条第二款的规定。

（3）权利要求3-6、29-32、61-63、83和88-91对其引用的权利要求进一步限定的技术特征已经在对比文件1中公开（参见上述意见（2）），例如在说明书第16栏公开的改性硅油落入权利要求6的保护范围之内，其相当于R1、R2和R3为甲基，R4为取代的烷基，因此权利要求3-6、29-32、61-63、83和88-91相对于对比文件1不具有新颖性，不符合专利法第二十二条第二款的规定。

（二）创造性

2、权利要求2和7-26直接或间接对权利要求1作了进一步限定；权利要求28和33-53直接或间接对权利要求27作了进一步限定；权利要求56-58直接或间接对权利要求54或55作了进一步限定；权利要求60和64-81直接或间接对权利要求59作了进一步限定；权利要求87和92-93直接或间接对权利要求86作了进一步限定，从说明书中无法看出上述限定后的技术方案相对于对比文件1产生任何意想不到的技术效果，因此权利要求2、7-26、28、33-53、56-58、60、64-81、87和92-93不具有创造性，不符合专利法第二十二条第三款的规定。

（三）在申请人克服新颖性缺陷，提供充分的证据证明本申请具有创造性的前提下，本申请还存在如下问题：

3、（1）权利要求1的保护范围过宽，在说明书中只公开了权利要求6-8、13、15和18中的非挥发性液体，而权利要求1请求保护的非挥发性液体，结构不同，性质不同，本

领域技术人员无法预测所有的非挥发性液体能够解决同样的技术问题，达到同样的技术效果，因此权利要求1的保护范围过宽，不符合专利法第二十六条第四款的规定。

(2) 同理，独立权利要求27、54、55、59、82、84-86和94中涉及的非挥发性液体概念过宽，得不到说明书的支持，不符合专利法第二十六条第四款的规定。

(3) 权利要求91请求保护的技术方案没有在说明书中出现，因此形式上得不到说明书的支持，不符合专利法第二十六条第四款的规定。建议申请人将其加入到说明书中去。

4、(1) 权利要求6、32和63对取代基定义出现“取代或未取代烷基、具有UV吸收性或抗氧化剂能力的官能取代基”，取代的烷基没有给出取代基的定义，而官能取代基是什么不清楚，导致上述权利要求的保护范围不清楚，不符合专利法实施细则第二十条第一款的规定。

(2) 权利要求26中出现的氧化硅说明书中的硅石不一致，导致权利要求26保护范围不清楚，不符合专利法实施细则第二十条第一款的规定。

基于上述理由，本申请按照目前的文本是不能被授予专利权的，申请人应当在指定的期限内克服上述缺陷，否则本申请将被驳回。

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